

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOMOHIRO MIYAHIRA

Appeal No. 2007-0346
Application 09/812,438
Technology Center 2100

Decided: May 11, 2007

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP,
and JEAN R. HOMERE, *Administrative Patent Judges*.

Per Curiam.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

The Appellant appeals from the Patent Examiner's final rejection of claims 1-16, 18, 20, 22, 24, 25, and 28¹ under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

¹ Claims 17, 19, 21, 23, 26, and 27 have been cancelled.

A. INVENTION

The invention at issue on appeal is a client-server system for translating text in a web page (Specification 1). More specifically, a client 300 employs a function execution request object 220 to request translation of a target web page 210. Upon receiving the request, a conversion server 100 obtains the target web page from a web server 200, translates the web page 210, and returns the translation to the client 300. (*Id.* 12-13).

Claims 1, 11, and 12, which further illustrate the invention, follow.

1. A network system comprising:

 a client for browsing web pages;

 a server for providing a function to perform a predetermined process for said web pages; and

 a web server for storing a web page that includes a function execution request object which is used to request that a process be performed by said function providing server,

 wherein said client obtains, from said web server, said web page that includes said function execution request object, and when said function execution request object included in said web page is selected, said client designates the storage location for a target web page and transmits a process execution request to said function providing server,

 wherein, upon the receipt of said process execution request from said client, said function providing server obtains said target web page based on said storage location that is

designated by said process execution request, performs a pertinent process for said target web page that is obtained, and returns the resultant web page to said client that issued said process execution request,

wherein the function execution request object is one of a button, a banner, a linking keyword, and an image data.

11. A web server, for storing a web page that is browsed by means of a communication network, comprises:

storage means for storing a web page, including both a description of a URL for a function providing server, which performs a translating process for a web page, and a description of an option for obtaining a URL for a web page that is inserted into said web server, the translating process configured to translate, at least in part, the web page from a first language to a second language; and

communication control means for accepting a request to browse the web page and for returning said web page to the source that transmitted said request.

12. A web page comprising:

a first script, for displaying a function execution request object on a web page; and

a second script, performed in response to the selection of said function execution request object on said web page, which is displayed by predetermined display means, for obtaining the URL of said web page and for transmitting the URL to a function providing server that has been registered in advance; and

wherein the function execution request object is one of a button, a banner, a linking keyword, and an image data.

B. REJECTIONS

The Examiner relies on the following references:

Hobbs US 5,987,454 Nov. 16, 1999

Gabbard US 6,205,432 B1 Mar. 20, 2001

Claims 1-3, 5-7, 11-16, 18, 20, 22, 24, 25, and 28 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Hobbs. Claims 4 and 8-10 stand rejected under 35 U.S.C. § 103 (a) as being obvious over the combination of Hobbs and Gabbard.

II. CLAIMS 1-10, 13, 14, 18, 20, AND 24

Rather than reiterate the positions of the parties *in toto*, we focus on the issue therebetween. The Examiner asserts, "Hobbs discloses a . . . client designat[ing] the storage location (selecting a data warehouse 230 fig.4 for the requests) for a target web page and transmits a process execution request to said function providing server (see col.15 lines 3-28). . . ." (Answer 4.)

The Appellant makes the following argument.

Claim 1 recites, "said function providing server obtains said target web page based on said storage location that is designated by said process execution request, performs a pertinent process for said target web page that is obtained, and returns the resultant web page to said client that issued said process execution request." App., claim 1 (emphasis added). The Examiner does not provide any evidence in the record that

Hobbs discloses a function providing server as recited in claim 1.

(Br. 4.) Therefore, the issue is whether Hobbs discloses that a request to execute a process designates the storage location of a target web page.

In addressing the issue, the Board conducts a two-step analysis. First, we construe independent claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

A. CLAIM CONSTRUCTION

Our analysis begins with construing the claim limitations at issue. "The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations: said client designates the storage location for a target web page and transmits a process execution request to said function providing server,

wherein, upon the receipt of said process execution request from said client, said function providing server obtains said target web page based on said storage location that is designated by said process execution request. . . .

Claims 5, 13, and 14 recite include similar limitations. Considering all the limitations, claims 1, 5, 13, and 14 require that a request to execute a process designates the storage location of a target web page.

B. ANTICIPATION DETERMINATION

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims."

In re Cruciferous Sprout Litig., 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. . . ." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Hobbs "concerns a multi-tier client/server model for record retrieval wherein optimum record retrieval from a database is achieved. . . ." (Col. 1, ll. 14-15.) "FIG. 5 is a flowchart of the method of operating the [reference's] information retrieval system. . . ." (Col. 15, ll. 29-30.) As part of the method, "browser 204 sends a request to Proxy Server 207 (shown in FIG. 4)." (Col. 16, l. 21.) "The request comprises a request header specifying a purpose of the request ('http'), the network address of Proxy Server 207 to which the request header is applied ('www.example.com'), a file name of an application that is stored on Proxy

Server 207 ('datasite.pl'), and an argument that acts as a key in a table lookup and corresponds to the request ('AR1')." (Col. 15, ll. 57-63.) We fail to find, however, that the request designates the storage location of a target web page. Rather, it helps to locate a storage medium (database server or data warehouse) for supplementing the contents of a webpage.

The absence of a request to execute a process that designates the storage location of a target web page negates anticipation. Therefore, we reverse the anticipation rejection of claims 1, 5, 13, and 14² and of claims 2, 3, 6, 7, 18, 20, and 24, which depend therefrom.

C. OBVIOUSNESS DETERMINATION

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "*A prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

2 Although claims 5, 13, and 14 each recite in pertinent part "the selection of a function execution request object," no such "selection" was previously recited in the claims. We leave it to the Appellant to correct this problem.

Here, claims 4 and 8-10 depend from claims 1 and 5, respectively. The Examiner does not allege, let alone show, that the addition of Gabbard cures the aforementioned deficiency of Hobbs. Absent a teaching showing that a request to execute a process designates the storage location of a target web page, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we also reverse the obviousness rejection of claims 4 and 8-10.

III. CLAIM 11

The Examiner asserts that Hobbs discloses "storage means (230 fig.4) for storing a web page," (Answer 7), and "communication control means (211 fig.4) for accepting a request to browse a web page (browsing web documents) and for returning said web page to the source that transmitted said request (sending back to clients' browsers the web documents, see fig.5, col.15 lines 29-63 and col.16 line 34 to col.17 line 32)." (*Id.*) The Appellant argues "that such an operation does not amount to a translating process. . ." (Appeal Br. 10.) Therefore, the issue is whether claim 11 requires a translating process.

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). "An intended use or purpose usually will not limit the scope of the claim because such statements usually do no

more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencil* 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Here, claim 11 recites in pertinent part the following limitations:

storage means for storing a web page, including both a description of a URL for a function providing server, which performs a translating process for a web page, and a description of an option for obtaining a URL for a web page that is inserted into said web server, the translating process configured to translate, at least in part, the web page from a first language to a second language; and

communication control means for accepting a request to browse the web page and for returning said web page to the source that transmitted said request.

The claim is directed toward a storage means and a communication control means; it does not require a server for performing a translating process. Because the phrase "a translating process for a web page . . . , the translating process configured to translate, at least in part, the web page from a first language to a second language," merely states an intended use of or purpose for the webpage, the phrase is not entitled to patentable weight. The Appellant's argument not being commensurate with the scope of the claim, we affirm the anticipation rejection of claim 11.

IV. CLAIMS 12, 15, 16, 22, 25 AND 28

A. BOARD'S REJECTION

Under 37 C.F.R. § 41.50(b) (2006), we enter a new rejection against claims 12, 15, 16, 22, 25, and 28. "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope."

In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991)). The "inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity."

In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In particular, a claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited. . . ."

Ex parte Moelands, 3 USPQ2d 1474, 1476 (B.P.A.I. 1987).

Here, claims 12, 15, and 16 each recite in pertinent part "the selection of said function execution request object on said web page." Because no such "selection" was previously recited in the claims, the claims are indefinite. Claims 22, 35, and 28, which depend therefrom, are also indefinite.

Each of the claims, moreover, recites in pertinent part the following limitations:

a first script, for displaying a function execution request object on a web page; and

a second script, performed in response to the selection of said function execution request object on said web page, which is displayed by predetermined display means, for obtaining the URL of said web page and for transmitting the URL to a function providing server. . . .

For its part, the Appellant's specification distinguishes between two web pages. The first web page is one stored "in a web server 200," (Specification 12), which is shown in Figure 1 of the specification. The second web page is one that a user has downloaded to a client machine 300, which is also shown in the Figure.

According to the specification, "[w]hen a user . . . clicks on a function button 220 pasted on the web page 210, a conversion request is issued to the conversion server 100." (*Id.*) Figure 2 of the specification shows that the function button 220 is on the web page that was downloaded to the client, rather than on the web page that is stored in the web server.

"Upon the receipt of the request, the conversion server 100 changes the web page 210 by using the function corresponding to the function button 220. A thus obtained web page 150 is subsequently transmitted to the client machine 300." (*Id.* 12-13.) Once again, Figure 2 shows that the change is made to the web page that was downloaded to the client, rather than to the web page that is stored in the web server.

Figure 2, however, merely depicts "the concept" of the conversion service (*see* Specification 10: 1-2; 12: 3-4), as it might be observed by a user at a client machine who requests the service. As understood by the skilled

artisan, in contrast, scripts, programs, and files that are suitable for use by a web page browser are downloaded to the client machine from a web server. The local content possessed at the client machine serves to reproduce the content of the "web page" on the web server, but the local (i.e., browser-resident) content is separate and distinct from the "web page" on the server.

As described in the more detailed description of the embodiment, the client machine 300 provides the URL of the "web page 210" to be converted (Specification 13: 11-24). The URL of the "web page" that the client machine sends is the URL of the web page that is "currently being browsed"; e.g., "ibm.com." (*See id.* 21: 4-26). The URL sent by the client machine is not the URL of the client machine, but the URL of the source of the version of the web page that is present in the client machine's browser; i.e., a "web page" on a server or a "target" web page.

As we have noted *supra*, "the selection" in each of independent claims 12, 15, and 16 lacks proper antecedent basis in the claim. The Appellants do not describe any "selection" of a function execution request object on a web page server. It thus seems that claim 12, for example, must refer to the version of the "web page" present in the client's browser. The claim further recites, however, that a script, responsive to the selection, is for obtaining "the URL of *said* web page" and for transmitting the URL to a function providing server. "Said" web page can only refer to the version of the web page that is present at the client machine. Although the web page present at the server and the scripts, programs, and files that reproduce the

content at the client may be identical in concept, in reality the URL of the client and the URL of the source of the content are different.

For the aforementioned reasons, we conclude that claims 12, 15, 16, 22, 25 and 28 fail to reasonably apprise those of skill in the art of their respective scope.³ Therefore, we reject these claims under 35 U.S.C. § 112, ¶2 as indefinite.

B. EXAMINER'S REJECTION

A rejection should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious-the claim becomes indefinite." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Here, for the reasons explained in addressing the indefiniteness of claims 12, 15, 16, 22, 25, and 28, our analysis of the claims leaves us in a quandary as to what they specify. Speculations and assumptions would be required to decide the meaning of the terms employed in the claims and the scope of the claims. Therefore, we reverse *pro forma* the anticipation rejection of claims 12, 15, 16, 22, 25, and 28.

³ To the extent that the claims might be interpreted as requiring the obtaining of the URL of *the client machine* and transmitting that URL to a function providing server, we do not find, at the least, written description (35 U.S.C. § 112, ¶1) support for such a "script" or "means."

We emphasize that our reversal is based on procedure rather than on the merits of the obviousness rejections. The reversal is not to be construed as meaning that we consider the claims to be patentable as presently drawn. For example, the Appellant's sole argument for claims 12 and 16 is that "the request headers discussed in Hobbs are not one of a button, a banner, a linking keyword, and an image data, selectable or displayed in a displayed web page." (Appeal Br. 10.) Because Figure 5 of the reference shows "the Linked Term [a]s the phrase 'AUTOMOTIVE-RELATED INDUSTRY,'" (col. 15, ll. 44-45), we find that the Linked Term constitutes a linking keyword.

V. ADDITIONAL OBSERVATIONS

"In the course of examining . . . , the examiner . . . may require the submission . . . of such information as may be reasonably necessary to properly examine or treat the matter, for example . . . [t]echnical information known to applicant concerning the related art . . . pertinent to patentability. . ." 37 C.F.R. § 1.105(a)(1)(viii) (2006). Here, the Appellant briefly mentions the translation service of AltaVista. (Specification 2.) Because we are cannot help but notice the similarity between the Appellant's invention and the translation service, we suggest that the Examiner obtain further technical information about the service and consider whether the claims are patentable over the service.

VI. CONCLUSION

In summary, the rejection of claims 1-3, 5-7, 13, 14, 18, 20, and 24 under § 102 (e) and the rejection of claims 4 and 8-10 under § 103(a) are reversed. The rejection of claim 11 under § 102(e), however, is affirmed. The rejection of claims 12, 15, 16, 22, 25, and 28 under § 102 (e) is reversed, but a new rejection under § 112, ¶2 is entered against these claims.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii).

Accordingly, our aforementioned affirmance is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

37 C.F.R. § 41.50(b)(2006) provides that "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART

37 C.F.R. § 41.50(b)

HOMERE, *Administrative Patent Judge, dissenting-in-part.*

I agree with the majority's holding in all respects save one. I write separately to voice my disagreement with the majority's holding that claims 12, 15, 16, 22, 25, and 28 are indefinite. Because the majority concludes that the cited claims are indefinite, it reverses pro forma the Examiner's prior art rejection of the claims and enters a new ground of rejection against those claims. From that decision, I respectfully dissent.

First, the majority opinion states at page 10:

Here, claims 12, 15, and 16 each recite in pertinent part "the selection of said function execution request object on said web page." Because no such "selection" was previously recited in the claims, the claims are indefinite. Claims 22, 35, and 28, which depend therefrom, are also indefinite.

In support of this first conclusion, the majority opinion cites to a number of cases⁴ generally pertaining to indefiniteness. However, the majority failed to explain how the cited authorities support their conclusion that the cited claim language is indeed indefinite.

⁴ "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991)). The "inquiry therefore is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). In particular, a claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited. . . ." *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (BPAI 1987).

Second, the majority opinion states at page 12:

As we have noted *supra*, "the selection" in each of independent claims 12, 15, and 16 lacks proper antecedent basis in the claim. The Appellants do not describe any "selection" of a function execution request object on a web page server. It thus seems that claim 12, for example, must refer to the version of the "web page" present in the client's browser. The claim further recites, however, that a script, responsive to the selection, is for obtaining "the URL of said web page" and for transmitting the URL to a function providing server. "Said" web page can only refer to the version of the web page that is present at the client machine. Although the web page present at the server and the scripts, programs, and files that reproduce the content at the client may be identical in concept, in reality the URL of the client and the URL of the source of the content are different.

For the aforementioned reasons, we conclude that claims claim 12, 15, 16, 22, 25 and 28 fail to reasonably apprise those of skill in the art of their respective scope.⁵ Therefore, we reject these claims under 35 U.S.C. § 112, ¶2 as indefinite. (Emphasis added).

In support of this second conclusion, the majority examines the relevant portions of Appellants' Specification. Yet, once again, the majority fails to show how the cited legal authorities support their conclusion.

I agree with the majority that as set forth *In re Wamerdam*, to meet the legal standard of definiteness, a claim must apprise those of skill in the art of its scope. Along the same line, our reviewing court has held that the test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Further, our

⁵To the extent that the claims might be interpreted as requiring the obtaining of the URL of *the client machine* and transmitting that URL to a function providing server, we do not find, at the least, written description (35 U.S.C. § 112, ¶1) support for such a "script" or "means."

reviewing court has held that the claim as a whole must be considered to determine whether the claim apprises one of ordinary skill in the art of its scope, and therefore serves the notice function required by 35 USC 112, second paragraph by providing clear warning to others as to what constitutes the infringement of the patent. *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claims so as to understand how to avoid infringement, a rejection of the claim under 35 USC 112, second paragraph is deemed appropriate. *Morton Int'l, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

At the outset, it is important to note that all the cases cited above require that claim definiteness be evaluated from the point of view of one of ordinary skill in the pertinent art. Plainly, in the cited authorities, our reviewing court mandates that a claim is deemed as being indefinite if the ordinarily skilled artisan cannot understand (the scope of) what is claimed after having read the specification. Today, the majority opinion ignores such a mandate and holds that the claimed invention is indefinite despite the fact that they appear to ascertain the scope of Appellants' claims. After having analyzed the relevant portions of Appellants' Specification, the majority opinion finds "the selection of a function execution request object on said webpage," as recited in claim 12, must refer the Client's webpage (210)

downloaded from the server (200). Further, the majority finds that "Said" web page can only refer to the version of the web page that is present at the client machine.⁶ Still, the majority went on to hold that the claim is indefinite because the URL of the webpage (210) at the client is different from the URL of the webpage (210) at the web server. These findings on the part of the majority are evidence that the majority does understand the scope of the claim. Further, I re-emphasize here the role that our reviewing court has delegated to the ordinarily skilled artisan in assessing claim definiteness.⁷ Ordinarily skilled artisans are individuals that have acquired a firm grasp on the fundamentals of a particular art. They have acquired a certain level of expertise within a particular field. Thus, they must be imputed with at least a basic technical knowledge within that particular field.

⁶ It is important to note that the claim calls for "obtaining the URL of said webpage." (i.e. webpage (210)). As depicted in figure 2, the webpage (210) and function button (220) stored at the web server (200) are downloaded onto the client machine (300) such that the client can issue a request to conversion server (100) to translate the downloaded webpage (210). Thus, the content of the webpage (210) at the Client is only changed after it has been translated by the conversion server. (Specification 11, ll. 8-13; 12:19-13:3). Thus, although the URL of the webpage (210) at the web server and the URL of the web page (210) at the Client might be different, it is the same webpage (210) that is being forwarded to the conversion server regardless of which URL is obtained.

⁷ See *In re Wamerdam, Orthokinetics, Inc.* at page 17 *supra*.

Such knowledge, I believe, must always be taken into consideration when we stand in the shoes of such ordinarily skilled individuals.⁸

It appears to me that the majority is not actually confused as to what the scope of the claim is. Rather, the majority simply does not prefer the use of the language “the selection.” I believe that such personal preferences of language to improve clarity and precision of a claim are not a proper ground for rejecting that claim under 112, second paragraph. Such personal preferences of language to improve clarity or precision of the claim would better serve their intended purposes if communicated to Appellants in the form of a suggestion.⁹ Thus, I cannot agree with the majority’s new ground of rejection. Further, I cannot agree with the majority’s pro forma reversal of the Examiner’s rejection. According, I would decide the Examiner’s prior art rejection of the claims on the merits.

⁸ One of ordinary skill in the art, having read the specification, would readily be apprised that the relevant portions of claim 12 could be rewritten as follows:

A first script for displaying a function execution request object on a web page, and a second script for obtaining the URL of the web page and for transmitting the URL to a function providing server; the first script is performed in response to selecting the function execution request object on the webpage.

⁹ *Id.* See MPEP 2173.02 .

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